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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/520,976	01/11/2005	Paul E. Adams	3190R-02	6467
7590 08/20/2007				
Lubrizol Corporation Patent Administrator Mail Drop 022B 29400 Lakeland Boulevard Wickliffe, OH 44092-2298		EXAMINER GOLOBOY, JAMES C		
		ART UNIT 1714		PAPER NUMBER
		MAIL DATE 08/20/2007		DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/520,976	Applicant(s) ADAMS ET AL.	
	Examiner James Goloboy	Art Unit 1714	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 29 May 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-15 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-15 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance.. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. All outstanding rejections have been overcome by applicant's amendment of 5/29/07. New grounds of rejection necessitated by the amendment are set forth below.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claims 1-2, 4, and 6-7 are rejected under 35 U.S.C. 102(b) as being anticipated by Koch (U.S. Pat. No. 4,479,888).

In column 5 lines 37-50 (Example 6), Koch discloses the reaction of isostearic acid and trishydroxymethylaminomethane, and the further reaction of that reaction product with polyisobutylenesuccinic anhydride (PIBSA). It is the examiner's position that during the further reaction, the fluid composition comprises both the reaction product of isostearic acid and trishydroxymethylaminomethane, as in component "a" of claim 1, and claims 2, 4, and 6, and the reaction product of that oxazoline product with PIBSA, forming a succinimide dispersant in accordance with component "b" of claim 1 and claim 7. Example 7 discloses a similar procedure utilizing a different aminoalcohol. In light of the above, the cited claims are deemed to be anticipated.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

6. Claims 1-4, 6-8 and 10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Higaki (U.S. Pat. No. 4,886,612) in view of Papay (U.S. Pat. No. 5,652,201)

From column 2 line 44 through column 3 line 26, Higaki discloses a lubricating oil comprising a compound having one of five formulas. In column 3 lines 45-49, Higaki teaches that the compound of formula I can be prepared by reacting 2-methyl-2-amino-1,3-propanediol or 2-amino-2-hydroxymethyl-1,3-propanediol (trishydroxymethylaminomethane), aminoalcohols as recited in claim 1, with a monocarboxylic acid. In column 3 lines 61-63 Higaki teaches that various branched fatty acids can be used as the carboxylic acid, including isostearic acid. In column 5 lines 8-

22 Higaki teaches that the compound can be formed by the reaction of trishydroxymethylaminomethane and isostearic acid in a mole ratio of 1:2.8. In columns 9-10 (Table 7, Sample No. A), Higaki discloses that the oil composition can also comprise an oil of lubricating viscosity and an antioxidant. While Higaki discloses in column 4 lines 64-68 that the composition can contain further additives, the difference between Higaki and the compositions of claims 1-8 and 10 is that the composition of Higaki does not specifically include a dispersant.

Papay discloses lubricating compositions, and in column 47 lines 51-58 discloses that they can be used for a wide variety of applications, as can the composition of Higaki. In column 13 lines 49-55 Papay teaches that ashless dispersants are a crucial additive for lubricating compositions, and in columns 14-37 teaches the types of dispersants recited in claim 7.

It would have been obvious to one of ordinary skill in the art to add the dispersants of Papay to the composition of Higaki, in order to prevent the formation of deposits.

7. Claims 1-4 and 6-15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Chung (U.S. Pat. No. 5,244,590) in view of Higaki.

In column 1 lines 8-27, Chung discloses a dispersant-viscosity index improver for lubricating compositions, and in column 56 lines 1-10 teaches that the compositions can be used as automatic transmission fluids and tractor fluids, as recited in claims 11-15. In column 30 lines 48-50 Chung teaches that the automatic transmission fluids contain a

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friction modifier, and in column 31 lines 7-14 teaches that the fluid can further contain succinimide dispersants. In the table from column 31 lines 49-59, Chung teaches that the preferred concentrations of friction modifier and dispersant overlap and encompass the ranges recited in claim 9. Chung does not disclose the specific friction modifiers recited in the currently presented claims.

The discussion of Higaki in paragraph 6 above is incorporated here by reference. Higaki discloses a compound meeting the limitations of the friction modifier of claims 1-4 and 6-15 and possessing friction-reducing properties. While Higaki discloses the use of the compound as a base lubricant and not an additive, it is noted that Higaki does disclose that the compound can be blended with other base oils.

It would have been obvious to one of ordinary skill in the art to use the oxazoline compound of Higaki as the friction modifier in the composition of Chung, as Higaki teaches in table 6 that compound has friction-reducing properties when blended in a minor amount with another lubricating oil.

8. Claim 5 is rejected under 35 U.S.C. 103(a) as being unpatentable over Higaki in view of Papay as applied to claims 1-4, 6-8, and 10 above, and further in view of Ichihashi (U.S. Pat. No. 5,972,854).

The discussion of Higaki and Papay in paragraph 6 above is incorporated here by reference. Higaki and Papay disclose a composition meeting the limitations of claim 1, but do not disclose a composition where the oxazoline compound is derived from an octadecylsuccinic acid or anhydride.

Ichihashi, in column 1 lines 52-57, discloses a lubricating composition for automatic transmissions comprising the reaction product of a carboxylic acid and an amine. In column 4 lines 36-64, Ichihashi teaches that the carboxylic acid can be octadecylsuccinic acid, as recited in claim 5, and the amine can be an alkanolamine.

It would therefore have been obvious to one of ordinary skill in the art to derive component a of claim 1 from a mixture comprising isostearic acid and octadecylsuccinic acid, in order to form both the oxazoline of Higaki and the additive of Ichihashi.

9. Claim 5 is rejected under 35 U.S.C. 103(a) as being unpatentable over Chung in view of Higaki as applied to claims 1-4 and 6-15 above, and further in view of Ichihashi (U.S. Pat. No. 5,972,854).

The discussion of Chung and Higaki in paragraph 7 above is incorporated here by reference. Chung and Higaki disclose an automatic transmission fluid meeting the limitations of claim 1, but do not disclose a composition where the oxazoline compound is derived from an octadecylsuccinic acid or anhydride.

Ichihashi, in column 1 lines 52-57, discloses a lubricating composition for automatic transmissions comprising the reaction product of a carboxylic acid and an amine. In column 4 lines 36-64, Ichihashi teaches that the carboxylic acid can be octadecylsuccinic acid, as recited in claim 5, and the amine can be an alkanolamine.

It would therefore have been obvious to one of ordinary skill in the art to derive component a of claim 1 from a mixture comprising isostearic acid and octadecylsuccinic

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acid, in order to form both the oxazoline of Higaki and the automatic transmission fluid additive of Ichihashi.

Response to Arguments

10. Applicant's arguments have been considered but are moot in view of the new grounds of rejection.

Conclusion

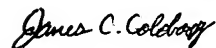
11. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to James Goloboy whose telephone number is 571-272-2476. The examiner can normally be reached on M-F 8-4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vasu Jagannathan can be reached on 571-272-1119. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.


JCG

/Vasu Jagannathan/
Supervisory Patent Examiner
Technology Center 1700